

BEST AVAILABLE COPY

Application No.: 10/784398

Case No.: 59555US002

REMARKS

Claims 1 to 23 are pending. Claims 1 to 17 have been withdrawn from consideration. Claims 18 to 23 are rejected. Claims 18 and 20 are hereby amended. Claims 24 to 26 have been added. Claims 24 to 26 are supported in the specification, e.g., at p. 8, lines 13-19.

§ 112 Rejections

Claim 20 stands rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards (or Applicants regard) as the invention.

The Office Action states in part:

It is vague and indefinite as to what is the film thickness with respect to the recess region.

Applicants have amended claim 20.

In summary, Applicant submits that the rejection of claim 20 under 35 USC § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

§ 103 Rejections

Claims 18-23 stand rejected under 35 USC § 103(a) as being unpatentable over Klun et al (US 5227008) in view of Skrtic et al (US 4898275).

The Office Action states in part:

Klun discloses a flexible circuit board comprised of a polymeric film and a photoresist mask (col 2 L 21-26).

The polymeric film can be a polycarbonate film (col 2 L 49-51). The polymeric film has a thickness from about 12-125 μ m (col 4 L 37-39).

The polymeric film is etched to obtain a reduced thickness, the etchant used is a basic solution (col 3 L 41-43 & L 33-35).

The final thickness of the polymeric film can be determined or controlled by the concentration of the etchant and the amount of time for etching (col 3 L 55-57). Since the polymeric film can be as thin as 12 μ m initially, it would have been obvious that after etching its thickness would be less than 12 μ m.

Applicant is reminded that it is the product itself which must be new and unobvious, see *In re Pinkington* 162 USPO 145, 147 (C.C.P.A 1969). Product by process claimed are not patentably distinct over product claims unless it can be shown that the product produced by the process is in some manner measurably distinct from the product produced by another process, therefore there will be no weight given to the product by process verses product claims.

BEST AVAILABLE COPY

Application No.: 10/784398

Case No.: 59555US002

The limitation of the etched recesses will not be given any weight, since etching is not the only way to form a recess.

Klun teaches the present invention but is silent about having a plurality of recesses. Also, Klun is silent about having another polycarbonate film or a thermoplastic film laminated to the polycarbonate film.

Klun teaches that a polyimide layer is coated onto a copper foil which is laminated onto the surface of the polycarbonate film (col 4 L 6-12). Polyimide is a known thermoplastic material. The examiner takes the position that this meet the limitation of claim 23.

Klun is silent about the article is a carrier pocket tape.

Skrtic teaches a carrier tape that is made from a thin polymeric material which can be a polycarbonate have a thickness from about 0.012 to 0.04 cm (ie. 120-400 μ m). The carrier tape has a plurality of recesses (Figures 1-4).

In view of the prior art teaching, one skill in the art would fabricate a carrier pocket tape that has the conventional thickness and conventional material (ie. polycarbonate) and slightly modify the structure because it is a matter of design choice.

Applicants respectfully submit that according to MPEP 2142, to establish a case of *prima facie* obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references or generally known to one skilled in the art, to modify or combine reference teachings, 2) there must be reasonable expectation of success, and 3) prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making the changes. *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984).

Applicants have amended claim 1 to state that the depth of the recessed region is less than the thickness of the dielectric film.

Applicants respectfully submit that the references cannot support a case of *prima facie* obviousness as to the claims because, among other possible reasons, the cited references do not provide a motivation or suggestion for a carrier tape in which the depth of the recessed region is less than the thickness of the dielectric film because Skrtic teaches making a carrier tape by injection molding or die casting while Klun teaches making a flexible circuit with etched recesses. (See Skrtic at col. 1, lines 45-54) As stated in *In re Skoll*, 523 F2d 1392, 187 USPQ 481 (CCPA):

Although references may be combined to show that a claim is unpatentable, they may not be combined indiscriminately. To determine whether a combination of references is proper, the following criterion is often used: namely, whether the prior art suggests doing what an applicant has done. It is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known.

BEST AVAILABLE COPY

Application No.: 10/784398

Case No.: 59555US002

Applicants submit that the Office Action is improperly combining references in hindsight based on Applicants' disclosure.

In addition, the cited references do not disclose all the elements of the present invention because they do not disclose a carrier tape in which the depth of the recessed region is less than the thickness of the dielectric film.

For these reasons, Applicants submit that the cited references will not support a 103(a) rejection of the claimed invention and request that the rejection be withdrawn.

In addition to the foregoing arguments, Applicants submit that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCairn*, 1012 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing, it is submitted that the application is in condition for allowance. Withdrawal of the rejections under 35 U.S.C. 112 and 103 is requested. Examination and reconsideration of the claims are requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant(s)' attorney if the Examiner believes any remaining questions or issues could be resolved.

Respectfully submitted,

October 14, 2005
Date

By: Melanie Gover

Melanie G. Gover, Reg. No.: 41,793
Telephone No.: (512) 984-4308

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833